

### **REMARKS**

Claims 1-11, 19-20, 41, 43, and 45-48 are pending in the application. Claims 12-18, 21-40, 42 and 44 have been canceled. Applicant respectfully requests reconsideration of the application and issuance of a notice of allowance.

On September 24, 2008, the undersigned attorney, Applicant's Associate Counsel for this matter, initiated a telephone interview with Examiner Tran. the rejections under 35 U.S.C. § 102 were discussed along with the references. The Examiner maintained the points addressed in the Final Office Action. In particular, the Examiner maintained that the art teaches the same adhesive as claimed and, therefore, inherently have the same property. No agreement was reached. Applicant and their attorney thank Examiner Tran for her time.

### **Rejections Under 35 U.S.C. § 102**

Claims 1-4, 18, 41, 43, and 45 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,366,087 to Bane. Claims 1, 5, 8, 11, 19-20, 41, 43, and 45-47 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,217,307 to McClintock. The Examiner acknowledges that neither Bane nor McClintock teach that the substrate is moisture resistant, the adhesive is removable and resealable in the presence of moisture from food packaging environments, and/or that the removable adhesive has a Moist Loop Test result of at least about 0.8N/25mm at a test plate temperature of 5°C. The Examiner contends, however, that Bane and McClintock teach the same components in the laminate and, therefore, the respective laminates would inherently have all the same properties as presently claimed. Applicant respectfully traverses this rejection.

A reference fails to anticipate a claim unless the reference discloses each and every element as set forth in the claim. (MPEP § 2131.) The reference must show the identical invention in as complete detail as is contained in the claim. (Id.) Each feature must be found either expressly or inherently in the reference. But "anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated

limitation.” (*Trascleen Corp. v. Bridgewood Serv., Inc.*, 290 F.3d 1364, 1373 (Fed. Cir. 2002).)

To establish inherency the Examiner bears the initial burden to provide a basis in fact and/or technical reasoning to support a position that the allegedly inherent feature necessarily flows from the cited reference. (*Ex parte Levy*, 14 USPQ 2d 1461, 1464 (BPAI 1990); MPEP § 2112(IV).) The Examiner must show that the missing descriptive matter (i) is necessarily present in the thing described in the reference, and (ii) would be recognized by persons skilled in the art as being necessarily present. (*In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); MPEP § 2112(IV). Further, inherency cannot be established by mere possibilities or probabilities. (*Id.*) The fact that a characteristic may be present is not sufficient to establish inherency. (*Id.*)

The Examiner admitted that both Bane and McClintock fail to disclose each and every element as set forth in the claims. **Specifically, the Examiner admitted that Bane and McClintock “[do] not specifically teach the substrate to be moisture resistant, the adhesive to be removable and resealable in the presence of moisture from food packaging environments, or its Moist Loop test result ...”** (See, e.g., Final Office Action, page 3.) The Examiner summarily stated that Bane and McClintock teach the components of the laminate and, therefore, inherently teach the other features of the claims. But such a conclusory statement does not satisfy the Examiner’s initial burden of showing that a particular characteristic is necessarily present. And the Examiner has not provided any basis in fact or technical reasoning to show that the materials disclosed by Bane or McClintock necessarily have the characteristics recited in the claims.

Contrary to the Examiner’s allegation, Bane does not teach “the same components” or the same adhesives in the laminate. Bane simply discloses in column 3, beginning at line 56 that the adhesives 14 and 15 may be selected from a wide variety of “conventional permanent and repositional adhesives.” This general disclosure, however, does not provide a reasonable basis in fact or evidence that all conventional repositional adhesives necessarily have a Moist Loop Tack or are removable and resealable in the presence of moisture from

refrigerated or frozen food packaging environments as recited in the claims. Moreover, disclosing specific examples of adhesives does not provide a reasonable basis in fact that such materials necessarily have a particular property.

Further even if it is possible for a conventional repositionable adhesive could have a Moist Loop Tack of 0.8N/25mm at 5°C, it is also possible for that not to be the case. And mere possibilities are not sufficient to establish inherency. Rather, to establish inherency, the Examiner must establish that it is necessary in all cases for “conventional” adhesives to have the recited properties.

Similarly, the Examiner has failed to establish that McClintock inherently discloses the claimed features. McClintock discloses that the adhesive may be “any of the well known types such as pressure sensitive adhesive of the acrylic removable or permanent type or emulsion permanent or removable rubber based permanent and emulsion removable.” (Col. 7, lines 38-43.) Again, the Examiner has not provided any evidence or technical reasoning to show that an acrylic removable adhesive or other type of removable necessarily has a particular Moist Loop Tack.

Consequently, Bane and McClintock fail to anticipate the claims because they fail to either expressly or inherently teach all the elements as recited in the claims. Further, the Examiner has not met the initial burden of demonstrating that Bane and McClintock necessarily teach certain features such as a moisture resistant substrate or a removable adhesive having a particular Moist Loop Tack. Applicant respectfully requests that the rejections under § 102(b) be withdrawn.

In the Final Office Action, the Examiner stated:

In response to Applicants' arguments that Bane teaches a wide variety of conventional permanent and repositionable adhesives, and not the types or classes of permanent or repositionable adhesives as previously claimed, it is noted that since Bane teaches the adhesives as claimed, they would inherently have the same properties as claimed. Again, Applicants are reminded to include the chemical or structural elements to impart these properties in order to be patentable distinct over the prior art. The presently claimed invention recites the permanent and repositionable adhesives in general, thus what is taught by Bane would anticipate the claims.

(7/10/2008 Office Action, page 7).

Applicant will address these remarks in reverse order.

First, the Examiner is not applying the correct standard for anticipation. A reference fails to anticipate a claim unless the reference discloses each and every element as set forth in the claim. (MPEP § 2131.) But, by stating that the claims recite “the permanent and repositional adhesives in general, thus what is taught by Bane would anticipate the claims” (emphasis added), the Examiner is ignoring or disregarding claim limitations. In particular, the Examiner disregards the limitations that the removable adhesive is removable or resealable in the presence of moisture and has a Moist Loop Test result of at least about 0.8 N/25 mm at a test plate temperature of 5°C. This is improper because the USPTO “must consider all claim limitations when determining patentability of an invention over the prior art.” (*In re Lowry*, 32 F. 3d. 1579, 1582 (Fed. Cir. 1994).) That is, “[c]laim limitations defining the subject matter of the invention are never disregarded.” (*In re Sabatino*, 480 F.2d 911, 913 (CCPA 1973).)

Next, Applicant does not believe it is necessary to include chemical or structural elements that impart the claimed properties. The Examiner has provided no basis for this requirement. The claims sufficiently describe the structure of the adhesive article and sufficiently describe what features are required of the removable adhesive. The claimed article as a whole distinguishes from the art cited by the Examiner because the art does not show every claim limitation and, in particular, does not show an adhesive article that includes a removable adhesive that is removable and resealable and has a Moist Loop Test result of at least about 0.8 N/mm at a test plate temperature of 5°C. It is through Applicant’s discovery of providing an article with an adhesive with these properties that the desired advantages are achieved.

Finally, and as discussed above and in previous responses, the Examiner has not shown that Bane or McClintock inherently disclose the recited Moist Loop Test. **The Examiner admits that both Bane and McClintock fail to disclose each and every element as set forth in the claims.** The Examiner’s statement that “since Bane teaches the adhesive as claimed, they would inherently have the same properties as claimed” does not satisfy the Examiner’s initial burden of showing that a particular characteristic is necessarily present. The Examiner has not provided any basis in fact or technical reasoning to show in every case

“conventional adhesives” necessarily have the characteristics recited in the claims.

The mere disclosure of conventional adhesives does not provide a reasonable basis in fact or evidence that such materials necessarily have a particular property let alone a minimum value of a particular property such as, for example, Moist Loop Tack. Moreover, even if a conventional repositional adhesive could have a Moist Loop Tack of 0.8N/25mm at 5°C, mere possibilities are not sufficient to establish inherency.

McClintock actually supports Applicant’s argument that the Examiner failed to establish inherency. McClintock discloses that the adhesive may be “any of the well known types such as pressure sensitive adhesive of the acrylic removable or permanent type or emulsion permanent or removable rubber based permanent and emulsion removable.” (Col. 7, lines 38-43 (emphasis added).) This statement illustrates that an adhesive based on a particular class of polymer, e.g., acrylic, may be provided as a permanent or a removable adhesive. This shows that a person skilled in the art would understand that materials in the same class of materials (e.g., acrylics) may exhibit different adhesive properties. That is, a particular class of material does not necessarily exhibit or possess a certain property or characteristic such as, for example, a particular adhesive strength or tack.

Consequently, Bane and McClintock fail to anticipate the claims because they fail to either expressly or inherently teach all the elements as recited in the claims. The Examiner has not met the initial burden of demonstrating that Bane and McClintock necessarily teach certain features such as a moisture resistant substrate or a removable adhesive having a particular Moist Loop Tack. Applicant respectfully requests that the rejections under § 102(b) be withdrawn.

### **CONCLUSION**

In view of the foregoing remarks and the remarks presented in the previous Response, Applicant respectfully requests a timely issuance of a Notice of Allowance for claims 1-11, 19-20, 41, 43, and 45-48.

In the event any fees are due in connection with the filing of this document, the Commissioner is authorized to charge those fees to our Deposit Account No. 18-0988 under Attorney Docket No. **AVERP3447USA**.

Respectfully submitted,

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